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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
03-593-D

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name _____Application Number
10/519,533Filed
December 27, 2004First Named Inventor
Brad LewisArt Unit
2457Examiner
Hee Soo Kim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/David L. Ciesielski/

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 _____

October 7, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☒

*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 03-593-D)

In re Application of:)	
)	
Brad Lewis)	
)	Group Art Unit: 2457
Serial No.: 10/519,533)	
)	Examiner: Hee Soo Kim
Filed: December 27, 2004)	
)	Confirmation No. 2537
For: PORTAL FOR DISTRIBUTING)	
BUSINESS AND PRODUCT)	
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REASONS FOR REQUESTING REVIEW OF FINAL OFFICE ACTION

Pursuant to the Pre-Appeal Brief Conference Program, Appellant requests review of the Final Office Action (FOA) mailed on April 12, 2010 because the Examiner clearly erred in rejecting the pending claims of this application.

- 1. Status of the claims** - Claims 67 to 83, 85, and 86 are pending. Of the pending claims, claim 67 is independent. In the FOA, (i) the Examiner rejected claims 67, 78 to 81, and 86 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,112,206 (Morris) in view of U.S. Patent Application Publication No. 2001/0054087 (Flom), (ii) the Examiner rejected claims 68 to 77 under 35 U.S.C. § 103(a) as being unpatentable over Morris in view of Flom and U.S. Patent No. 6,611,740 (Lowrey), and (iii) the Examiner rejected claims 82, 83, and 85 under 35 U.S.C. § 103(a) as being unpatentable over Morris in view of Flom and Official Notice.
- 2. Claim 67** - The Examiner clearly erred in rejecting claim 67 because, at a minimum, Morris and Flom do not logically lead to ***"a user interface that displays a status of whether the replication information at the replicating device is up-to-date, possibly outmoded, or outmoded."***

In the FOA, at page 4, last paragraph, and page 5, first paragraph, the Examiner stated, Flom taught a system including a portable device for presenting users with portable device applications and content. The portable device includes a cache for caching (replicating) content packages (abstract). A user of Portable device 94 can input search requests and commands. Searchable content packages may be cached on the portable device 94 in intelligent cache 94C. Once a content package has been cached

in cache 94C, subsequent user requests on portable device 94 will have local access to the updated cache information [¶36]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement, a user interface that displays a status of whether the information replicated by the replicating device is up-to-date, possibly outmoded, or outmoded[,] as it would eliminate or minimize the need to send requests to server 92 and download information each time a request is made [Flom: ¶36].

Appellant submits that the foregoing conclusion of obviousness is erroneous. Flom discloses (i) caching information in cache 94C with information received from server 92 in response to server 92 requesting content packages from content manufacturing system 90, and (ii) server 92 may be capable of running an application that can review a *user's past searching behavior* and, based thereon, anticipate future types of content requests the user might make, and content packages relating to the determined type of content can then also be streamed to the portable device 94 concurrent with subsequent *user requests*. See, Flom, ¶ 0035 and ¶ 0036. Appellant submits that caching information in cache 94C based on *user requests* or a *user's past searching behavior* does not logically lead to “*a user interface that displays a status of whether the replication information at the replicating device is up-to-date, possibly outmoded, or outmoded.*”

Furthermore, Flom discloses, “The content package streaming from server 92 to portable device 94 can be performed in *background mode*, permitting the portable device application to continue to serve content even while cache 94C is being updated.” See, Flom, ¶ 0038, emphasis added. Since the *server* of Flom determines the content to be streamed to portable device 94, and considering Flom's emphasis on the portable device serving content and streaming content packages to portable device 94 in the *background mode*, Appellant submits that a person having ordinary skill in the art at the time of the invention would not have modified the portable data terminals of Morris to include a *user interface that displays a status of whether the replication information at the replicating device is up-to-date, possibly outmoded, or outmoded.*”

Furthermore still, Flom (abstract) discloses (i) the portable device includes a cache for caching content packages on the portable device, and (ii) in response to a user submitting a request to the portable device application, the portable device cache is searched and used to fulfill the user request when relevant content packages are available in the portable device cache for fulfilling the request. Based on those teachings of Flom, as far as Appellant can tell, the user interface that allegedly would have been obvious to implement would be on the user's portable device. Appellant submits that a user interface on a *portable device* that displays a status of information cached on cache of the *portable device* does not amount to a user interface of the claimed *vehicle diagnostic*

device since the *replicating device* of claim 67 is not within the *vehicle diagnostic device*. Indeed, if the replicating device of claim 67 was within the vehicle diagnostic device, then the element “wherein the replicating device provides the at least a portion of the replication information to the vehicle diagnostic device in response to the request” would be unnecessary as the vehicle diagnostic device would already have the at least a portion of the replication information.

Furthermore still, with regard to a user interface, Flom, at best, discloses (i) web pages created by computer software program of portable web site 18 are communicated to and from the user via a user interface on portable electronic device 94, and (ii) portable web sites 18 provide a user interface on a portable electronic device 94 for finding relevant content and requesting application services such as search services for searching for information, routing, (e.g., directions), map display as well as optionally requesting call center system 20 services such as reservations and ticketing. *See*, Flom, ¶ 0056 and ¶ 0058.

In rejecting claim 67, the Examiner stated, “Morris does not specifically teach a user interface that displays a status of whether the replication information at the replicating device is up-to-date, possibly outmoded, or outmoded.” *See*, FOA, page 4, fourth paragraph. Accordingly, even if a person having ordinary skill in the art at the time of Appellant’s invention would have modified the portable terminal device of Morris to include Flom’s user interface that communicates web pages and requests services for searching for information, routing and map display, Appellant submits that Morris and Flom do not logically lead to “*a user interface that displays a status of whether the replication information at the replicating device is up-to-date, possibly outmoded, or outmoded.*” For the foregoing reasons, Appellant submits that the Examiner clearly erred in rejecting claim 67 and claim 67 is therefore allowable.

3. Claim 79 - Claim 79 recites, *inter alia*, wherein the first wireless access device is configured to automatically detect a beacon signal from the moveable land-based vehicle, and *wherein the vehicle diagnostic devices requests the replicated information in response to the beacon.*

In the FOA, the Examiner cited to Morris, column 16, lines 20 to 22, for teaching those elements of claim 79. That portion of Morris states, “A first wireless communication capability as identified by the numeral 347 exists between the MAS 331 and each of the plurality of data collection terminals 312 a, b --- n.” That portion of Morris does not disclose or suggest *wherein the vehicle diagnostic devices requests the replicated information in response to the beacon.*

Flom discloses, in response to a user submitting a request to the portable device application, the portable device cache is searched and used to fulfill the user request when relevant content

packages are available in the portable device cache for fulfilling the request. Even assuming *arguendo* that a person having ordinary skill in the art would have modified Morris with Flom, Appellant submits that Morris and Flom do not logically lead to *wherein the vehicle diagnostic device requests the replicated information in response to the beacon*, as recited in claim 79. Accordingly, Appellant submits that the Examiner clearly erred in rejecting claim 79 and claim 79 is therefore allowable.

4. Claim 86 - The Examiner clearly erred in rejecting claim 86 because, at a minimum, Morris and Flom do not logically lead to “wherein the program instructions further comprise instructions executable by the processor to *prompt a user to determine if the replicated information on the replicating device should be updated via a remote network.*”

In the FOA, the Examiner cited to Morris, column 18, lines 38 to 60, for teaching the limitation of claim 86. That portion of Morris and portions of Morris adjacent to that portion of Morris, disclose, *inter alia*, a step 404 in which it is determined whether the called new program, application overlay or application specific data is locally stored in the MAS 331, i.e., whether the requested information is stored in the mass storage 337, and (i) if locally stored, at a step 416, the requested information is transmitted back to the calling terminal, and (ii) if the requested information is not locally stored in the MAS 331, a request or SQL call is formatted during a step 406, the SQL request is sent to a server during a step 408, and, during a step 410, a timing period is initiated in which the requested new application, application overlay and/or application specific data is received back from the server 318. *See*, Morris, column 18, line 7, to column 19, line 23.

Even assuming *arguendo* that the MAS 331 amounts to the replicating device recited in claim 86, Appellant submits that determining whether a new program, application overlay, or application specific data *is locally stored* in the MAS 331, does not amount to determining if the replicated information on the replicating device *should be updated via a remote network*. Accordingly, even assuming *arguendo* that Morris and/or Flom disclose program instructions for determining whether a new program, application overlay, or application specific data *is locally stored* in the MAS 331, Appellant submits that those program instructions do not amount to program instructions comprising instructions executable by the processor to *prompt a user to determine if the replicated information on the replicating device should be updated via a remote network.*

In one case, if the new program, application overlay, or application specific data is not stored in the MAS 331, then the new program, application overlay, or application specific data is requested from a server and provided to the MAS 331 from the server. Appellant submits that determining the

new program, application overlay, or application specific data is not stored in the MAS 331 does not amount to *prompting a user to determine if the replicated information on the replicating device should be updated via a remote network.*

In the other case, if the new program, application overlay, or application specific data is stored in the MAS 331, then that new program, application overlay, or application specific data is transmitted to the calling terminal. Appellant submits that determining the new program, application overlay, or application specific data is stored in the MAS 331 does not amount to *prompting a user to determine if the replicated information on the replicating device should be updated via a remote network.*

Furthermore, although the foregoing steps 404, 406, 408, 410, and 416 are illustrated in the flow diagram of Figure 12 of Morris and although the flow diagram of Figure 12 illustrates the operation of the MAS 331 as carried out by the processor 332 executing the corresponding control program, Appellant submits that Morris, alone or in combination with Flom, does not disclose or suggest instructions executable by the processor *prompt a user to determine if the replicated information on the replicating device should be updated via a remote network*

For the foregoing reasons, Appellant submits that Morris and Flom do not logically lead to “wherein the program instructions further comprise instructions executable by the processor to *prompt a user to determine if the replicated information on the replicating device should be updated via a remote network,*” as recited in claim 86.

5. **Conclusion** - For the foregoing reasons, Appellant submits that the Examiner clearly erred in rejecting claims 67, 79, and 86. Additionally and/or alternatively, Appellant submits that dependent claims 68 to 83, 85, and 86 are allowable for at least the reason that each of those claims depends from allowable claim 67. The foregoing Reasons for Requesting Review of FOA accompany a Notice of Appeal and a Pre-Appeal Brief Request for Review. Accordingly, Appellant requests review of the FOA.

Respectfully submitted,

Date: October 11, 2010

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